PATENT
P56525RE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

In re Application of:

Appeal No. 2004-0677

KI-OOK PARK *et al.*

Original Patent No. 5,917,679 issued on 29 June 1999

Serial No.:	09/892,790	Examiner:	TUPPER, ROBERT S.
Filed:	28 June 2001	Art Unit:	2652

For: PSEUDO CONTACT TYPE NEGATIVE PRESSURE AIR BEARING SLIDER

PETITION UNDER 37 C.F.R. §1.181

Paper No. 36

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully petitions from the refusal by the Examiner to enter Appellant's Third Reply Brief filed on 25 October 2004 for the above-captioned application, and as reasons therefor states that:

Folio: P6525RE
Date: 7/25/05
I.D.: REB/kf

STATEMENT OF FACTS

1. In Paper No. 27, the Board of Patent Appeals And Interferences issued a *Remand To Examiner* dated on the 2nd of February 2004.

2. In Paper No. 28 dated on the 23rd of August 2004, the Examiner made an express withdrawal of the rejection of claims 21, 30 through 32 and 41 under 35 U.S.C. §251, and stated that the "application is being returned to the Board for its consideration of the remaining rejection of claims 21, 30-32, and 41 under 35 U.S.C. §102."

3. In Paper No. 29 filed by Appellant on the 18th of October 2004, Appellant made a cancellation of allowed claims 1 through 20, based upon a forthcoming issue of Appellant's co-pending U.S. Reissue Patent Application No. 10/314,937, which as of this date, remains pending in the Office of Patent Legal Administration.

4. On the 25th of October 2004, Appellant filed a *Third Reply Brief* pursuant to 37 CFR §41.43 and §41.50, in response to the Examiner's Paper No. 28 mailed on the 23rd of August 2004 and the withdrawal by the Examiner of the rejection of claims 21 through 60 under 35 U.S.C. §251.

5. In an unnumbered Paper mailed on the 12th of May 2005, the Examiner confirmed his entry of "Applicant's Amendment of 10/18/2004."

6. In an unnumbered Paper dated on the 24th of May 2005, the Primary Examiner wrote that:

> "[t]he reply brief filed 10/25/04 does not comply with 37 CFR §1.193(b)(1) because it was not filed within two months of the mailing date of the Examiners Answer (2/27/03)",

and,

> "Applicant appears to argue that the communication from the Examiner of 8/23/04 was a reopening of prosecution, thus allowing the filing of another reply brief. This is in error. ... The communication specifically stated that NO other changes were made to the Examiner's Answer. No response period was set. This was clearly NOT a reopening of prosecution. ... Note that in MPEP section 1208.03 there is a specific statement that an indication of change in status of claims (*e.g.*, that certain rejections have been withdrawn as a result of a reply brief) is not a supplemental Examiner's Answer. The fact that here the withdrawal was done *in response to a* ***remand*** *from the Board* for the Examiner to consider the impact of an intervening decision does not change the significance of the notice of withdrawal."

REMARKS

As explained on its face, Appellant's *Third Reply Brief* was written pursuant to 37 CFR §41.43 and §41.50, in response to the Examiner's Paper No. 28 mailed on the 23rd of August 2004 and the withdrawal by the Examiner of the rejection of claims 21 through 60 under 35 U.S.C. §251. The Examiner's reliance upon 37 CFR §1.193(b)(1) is not understood. This section of the regulations had been withdrawn long prior to the filing on the 25th of October 2004 of Appellant's *Third Reply Brief*, and had no counterpart in the regulations current as of on the 25th of October 2004 date of the filing of Appellant's *Third Reply Brief*. Instead, 37 CFR §4.50(a)(1) now provides that,

> "[t]he Board may also remand an application to the examiner."

while 37 CFR §4.50(a)(2) provides that,

> "[i]f a supplemental examiner's answer is written in response to a remand by the Board ..., the appellant **must** within two months from the date of the supplemental examiner's answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding: ... [r]equest that the appeal be maintained by filing a reply brief as provided in §41.41."

Here, despite his express reliance upon a non-existence §1.193(b)(1), the Examiner appears to argue that the withdrawal of a (*i*) rejection of all pending claims 21 through 60 under 35 U.S.C. §251, after the Examiner's earlier withdrawal of a (*ii*) rejection of claims 21 through 41 under the second paragraph of 35 U.S.C. §112, and earlier withdrawal of a (*iii*) rejection of

all of claims 21 through 60 under both the first and the second paragraphs of 35 U.S.C. §112, did not constitute "a supplemental examiner's answer [that was] written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1)" of 37 CFR §41.50. The deficiency with the Examiner's argument is that nothing in 37 CFR §41.50 restricts the appellation "supplemental examiner's answer" to a specific type of response by the Examiner to a remand by the Board of Patent Appeals and Interferences. Moreover, the overall scheme of the appellant regulations denies the Examiner's argument in support of his refusal to enter Appellant's *Third Reply Brief.*

Under the open-ended construction of 37 CFR §41.50, any response by the Examiner that "is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1)" qualifies as a "supplemental examiner's answer." As written, 37 CFR §41.50 is designed to expedite a compacted prosecution by eliciting a full and complete development of the issues to be decided by the Board, as opposed to a procedurally abbreviated development of those issues caused by a truncated briefing protocol which unfairly dumps upon the Board the task pondering the effect upon the remaining issues presented to the Board when the Examiner summarily, and without discussion, withdraws one of several outstanding final rejections. In essence, given that the earlier *Examiner's Answer* withdrew multiple rejections of substantially all pending claims, namely a (*i*) rejection of claims 21 through 41 under the second paragraph of 35 U.S.C. §112, and earlier withdrawal of a (*ii*) rejection of all of claims 21 through 60 under both the first and the second paragraphs of 35 U.S.C. §112, the scheme of the appellate rules contemplate an opportunity for the appellant to file a reply brief and, if appropriate, to address the effect of the withdrawal upon the remaining issues before the Board.

Each final rejection necessarily requires a primary examiner to make an interpretation of the language of each of the claims rejected. Where there are multiple, final rejections of each claim, each rejection may result in different, and possibly inconsistent, interpretations of the same claim. The opportunity for an appellant to prepare and file a reply brief enables the appellant to address and reconcile conflicting interpretations of a claim that may be present in the prosecution history, particularly where, as here, the withdrawal of all but one of the final rejections leaves a residual skein of inconsistent interpretations of each claim throughout the prosecution history.

The meaning of each phrase and clause of each claim before the Board is not always entirely self evident. During the compacted prosecution under current practice, an examiner is entirely free and unfettered to argue in support of one rejection of a claim in a final Office action and subsequently in an *Examiner's Answer*, that the language in a claim has one meaning, and to elsewhere in support of a different final rejection, to argue in the *Examiner's Answer* that the same language has a different, an even an irreconcilable meaning. An appellant however, must advance an wholly consistent interpretation of each claim, in traversal of each rejection, regardless of how divergent are the examiner's interpretations; the appellant dares not, under risk of such penalties as an accusation of indefiniteness under the second paragraph of 35 U.S.C. §112 or lack of enablement under the first paragraph of 35 U.S.C. §112 or lack of written description under the first paragraph of 35 U.S.C. §112, advance contrary, inconsistent, irreconcilable or even different interpretations of any claim. Where, as here, an Examiner's dogged instance upon the doctrine of *reissue recapture* throughout the prosecution history, followed by a summary withdrawal of that rejection devoid of any explanation of any the

fallacies in the interpretation of each claim that was made by the Examiner throughout the prosecution history to support the plausibility of each rejection where the claims in the parent patent had been broadened in scope by amendment during prosecution of the parent, robs the Board of the opportunity to read in Appellant's *Third Reply Brief* the Appellant's interpretation of the claims devoid of any of the fallacious inferences about the language of several of the claims made by the Examiner in arguing in an earlier *Examiner's Answer* for maintenance of each rejection under the doctrine of reissue recapture.

The current appellant scheme under seeks to enhance and clarify the interpretation of the claims by expressly granting under 37 CFR §41.50 an appellant upon issuance of a supplemental examiner's answer, expressly grants an Appellant two options, (*i*) reopen prosecution or (*ii*) maintain appeal. Here, Appellant sought the second option as being most likely to substantively advance the appeal. As was explained on page 9 of Appellant's *Third Reply Brief*, "Paper No. 28, and its overt withdrawal of 'the rejection of claims 21-60 under 35 U.S.C. §251' concomitantly raised issues that were neither addressed in the *Examiner's Answer* nor in Paper No. 28." By way of summary, the withdrawal of the *reissue recapture* rejection of **all** pending claims under 35 U.S.C. §251 implicitly negates, as false, the interpretations of these claims made by the Examiner throughout the multi-year prosecution, with, among other results, the loss of any interpretation on the record before the Board of the claims to support the remaining rejections under 35 U.S.C. §102(a). 37 CFR §41.50(a)(1) endows an appellant with the choice of the best mode for addressing the confusion caused by an examiner's summary withdrawal of a long-maintained rejection in order to clarify, and thereby simplify, the remaining issues faced by the Board. Forcing an appellant to rely upon an earlier *Reply Brief* does nothing to clarify,

or remove from the appellant discussion, explanations and reasoning about the language of claims presented during arguments made in traversal of a now withdrawn rejection; in other words, the mere fact that an appellant's explanation of a claim has been denominated in an earier *Reply Brief* as supporting a traversal of one rejection does not relieve the Board of the necessity of giving full consideration to that explanation when addressing other extent rejections, despite the fact that an examiner has subsequently, and without explanation, withdrawn that rejection. In short, only the presentation of an appellant's most recent *Reply Brief* to address the totality of the prosecution in light of the most recent action by the examining staff, gives the Board the benefit of the clearest and most succinct address to the extent issues presented by the remaining rejections, and permits the appellant an opportunity to identify which issues need no longer be given consideration by the Board.

RELIEF REQUESTED

For these reasons, Applicant respectfully requests the Commissioner to:

A. Enter the Third Reply Brief filed on 25 October 2005;

B. Accord Appellant a right pursuant to 37 CFR §41.50 to "maintain appeal ... by filing a reply brief as provided in §41.41;

C. Provide Appellant an opportunity to address, in writing, the effect and consequences upon any extent final rejection of the Examiner's withdrawal of a *reissue recapture* rejection under 35 U.S.C. §251; and

C. Grant such other and further relief as justice may require.

Respectfully submitted,

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